

revision of a document or document set, as recite in claim 1. Further, the Office Action acknowledges that Egendorf does not teach or suggest linkage information that includes links to an updated or revised document or document set based on a history identifier, as recited in claim 1. However, the Office Action asserts that Yanaka discloses such features in the Abstract and at col. 2-6.

Applicants assert that the Office Action's reliance on Yanaka to teach the admitted deficiency of Egendorf is based on an incorrect interpretation of Yanaka.

Yanaka, in the Abstract and at col. 2-6, cited by the Office Action, discloses a method of correctly detecting update contentions between databases in a distributed database system.

For example, as described in Yanaka, at col. 1, line 65 through col. 2, line 29, and with respect to Fig. 2, at col. 4, lines 1-36, and with respect to Fig. 9, at col. 6, lines 30-60, a primary replica database and a secondary replica database, in Yanaka, are each composed of sets of data. Each set of data represents an update unit within each of the respective primary and secondary databases.

For example, a set of data 201 includes: a data identifier 202 that uniquely identifies the set of data 201; a history identifier 203 that points to an update serial number history 207; and attribute data 204 that contains the actual data stored in data set 201. The update serial number history 207 contains: a node number 205 that identifies a computer originating an update; and an update counter 206 that stores a number indicative of the number of times set of data 201 has been updated.

As described in Yanaka at col. 6, line 30 through col. 7, line 49, update serial number history 207 associated with each set of data 201 supports a replication decision in which a data server decides whether or not it should update a set of data 201, stored within its database, to reflect a change in a corresponding set of data 201 reported by a remote data

server. The history table allows the receiving database to determine whether the dataset received is more recent than data currently stored in the database.

In general, if the data server determines, e.g., based on the update serial number history 207, that the received set of data 201 is more recent than the corresponding set of data 201 in its local database, the local database is updated with the received set of data 201. If the data server determines, e.g., based on the update serial number history 207, that the received set of data 201 is not as recent as the corresponding set of data 201 in its local database, the local database is not updated with the received set of data 201.

The Office Action cites Yanaka at col. 2-6 and the Abstract, and asserts that Yanaka teaches (1) a history identifier identifying an original and update or revision of a document or document set, and; (2) linkage information [that] includes links to the original and the update or revised document or document set based on the history identifier, as recited in claim 1. However, no such features are described in the passage cited.

For example, nowhere in the cited passage does Yanaka teach or suggest storing original as well as updates or revisions of a document or document set. Instead Yanaka teaches that a data set which is determined to be less current than a received data set is "updated" with the new received data set (e.g., see col. 6, lines 58-60). Nowhere does Yanaka teach or suggested that the previous version of the data set is saved, much less that the system in Yanaka maintains links to such previous versions of the data sets. For example, the data fields within update serial number history 207, i.e., node number 205 that identifies a computer originating an update, and an update counter 206 that stores a number indicative of the number of times set of data 201 has been updated, would not be suitable for maintaining links to such previous versions of the data sets, even if such previous versions were maintained.

Therefore, even if Yanaka were combined with Egendorf, the combination would not overcome the deficiency of Egendorf acknowledged by the Office Action.

B. Summary

For at least these reasons, the combination of Egendorf, Yanaka and Bengston cannot reasonably be considered to have suggested the combination of all of the features positively recited in claim 1. Claims 8, 9, 13 and 14, include features similar to claim 1. Therefore, a combination of Egendorf, Yanaka and Bengston cannot reasonably be considered to have suggested the combinations of all of the features positively recited in claims 8, 9, 13 and 14 for at least the reasons addressed above with respect to claim 1.

Additionally, claims 2-5, 7 and 10-12 each depend from one of independent claims 1 and 9. Therefore, a combination Egendorf, Yanaka and Bengston cannot reasonably be considered to have suggested the combination of all of the features positively recited in those claims, at least for their dependence upon one of independent claims 1 and 9, as well as the additional features each recites.

Accordingly, reconsideration and withdrawal of the rejections of claims 1-5 and 7-14 under 35 U.S.C. §103(a) as being unpatentable over any combination of Egendorf, Yanaka and Bengston are respectfully requested.

II. There Would Have Been No Motivation to Combine the Cited References

A. Egendorf/Yanaka Combination

As addressed above, the Office Action asserts at page 6, second paragraph, that it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate Yanaka's history identifier in the system of Egendorf because (1) it would have been desirable at the time of the invention to display any updates of data in one database to another so as to ensure that the latest contents were provided to all databases and (2) providing a history identifier of a document would ensure that the document set was up to

date and contained the most recent revisions of documents as opposed to an outdated document.

However, the Office Action's reliance on the above-stated motivation for combination is misplaced. For example, in Egendorf, the category based hierarchy is specifically designed to allow information to be located in different databases. Therefore, there is no benefit to the system described in Egendorf to "display any updates of data in one database to another so as to ensure that the latest contents were provided to all databases," as asserted by the Office Action. Further, the category based hierarchy in Egendorf is specifically designed to facilitate locating information sources stored in remote databases. The respective different databases are responsible for the integrity of the content presented, not the system described in Egendorf. Therefore, to supplement the system described in Egendorf with features designed to ensure that the contents maintained by the respective databases for which the system in Egendorf maintains search information is outside the intended purpose of the system described in Egendorf.

B. Egendorf/Yanaka/Bengston Combination

As addressed above, the Office Action asserts at page 7, second paragraph, that it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Bengston's workflow process steps specifying related process data files (i.e., documents) with Egendorf and Yanaka because it would have been desirable at the time of the invention to provide all documents needed for a process step in a workflow system in order to allow publishers, users, designers and other human operators in an organization to execute their assigned process electronically so as to reduce the costs involved in executing workflow steps manually.

However, the Office Action's reliance on the above-stated motivation for combination is misplaced. For example, the workflow system described in Bengston relates only to

workflows executed by automated devices. In Bengston, user input is merely provided with respect to setting up the automated workflow, and monitoring the execution of the monitored work flow. Since the workflows in Bengston relate only to automated workflows, a combination of Bengston with Egendorf and Yanaka cannot reasonably be expected to result in a system that provides all documents needed by human operators, e.g., publishers, users, designers etc., for execution of a process step in a workflow system executed by human operators so as to reduce the costs involved in executing workflow steps. In Bengston, process steps are performed by automated machines, not humans.

C. Summary

The above-described conclusory statements presented in the Office Action are not enough to prove that there is a teaching, suggestion or motivation in the prior art to combine these references in the manner suggested by the Office Action.

The Federal Circuit recently reaffirmed its prior holdings asserting that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, Appeal No. 04-1616, March 22, 2006 (Fed. Cir.) (quoting *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002), and *In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998)). The above conclusory statement is a mere assertion that does not meet the standard of some articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness.

MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *See also In re Mills*, 916

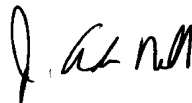
F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that the rejection of at least independent claim 1 is improper in view of at least MPEP §2143.01 because the Office Action lacks the required specific evidence of a teaching, suggestion or motivation in the prior art for one of ordinary skill to combine the references.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-5 and 7-14 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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